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09/855,195	05/14/2001	Raymond Jeffrey May	KCC-14,280	8182

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PAULEY PETERSEN KINNE & ERICKSON  
2800 WEST HIGGINS ROAD  
SUITE 365  
HOFFMAN ESTATES, IL 60195

EXAMINER

REICHLE, KARIN M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 03/01/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/855,195

Applicant(s)

MAY ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-24 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-24, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the <sup>Draftsman</sup> Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 19.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-9-03 has been entered.

### ***Election/Restrictions***

2. Claims 30-33 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 9-8-03 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a copy of each of the references has not been provided nor has the PTO-1449 of the EIDS mentioned by Applicant has not been received in the file, see NOTE in Paper No. 17. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of

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determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Specification***

#### ***Drawings***

4. The drawings were received on 11-5-03. These drawings are not approved by the Draftsman.

#### ***Claim Language Interpretation***

5. For purposes of the prior art rejections the claim language "targeted elastic material" is defined as set forth at page 7, lines 4-10, i.e. the elastic regions are made in the same process as is the elastic material or laminate made therefrom, i.e. separate manufacture of an elastic band and subsequent connection thereof to the underlying material to form the elastic material or laminate is not included. It is noted that the terminology "absorbent composite structure", "attached", and "permanently bonded" have not been specifically defined by the Applicants and thus will be given their broadest customary interpretation, i.e. the dictionary definition, in light of the specification. As set forth on page 14, last paragraph, page 18, lines 6-19 and page 20, lines 7-8 of the specification, the absorbent composite is the cover, liner and absorbent where coextensive, the side panels may be separate pieces attached to the composite or integrally formed therewith, i.e. an extension of a component of the composite structure, and the targeted elastic material forms the panels, i.e. may be integrated therewith. Therefore, in light of the

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specification, and the dictionary definition of "composite", i.e. "made up of distinct components; compound", the terminology "absorbent composite" is defined as the absorbent, cover and liner where coextensive and the "linear side edge" thereof being the linear area where they are all no longer coextensive. The terminology "attached" and "permanently bonded" are defined as being direct or indirect permanent bonding or attaching of separate elements to form a unitary structure or direct or indirect permanent bonding or attaching so as to form a monolithic structure.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 19-24 and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Gompel et al, EP '052.

See paragraph 5, supra, Figures, abstract, col. 1, lines 3-5, 19-20, 34-49, 55 et seq, col. 2, lines 10-14, col. 4, lines 14-16, 18-22, 33-39, col. 6, lines 13-51, col. 7, lines 16-54, col. 9, lines 18-24 (and thereby col. 4, line 31-col. 5, line 37 of '464), col. 8, lines 18-25, col. 8, line 51-col. 9, line 17 and claims, i.e. the chassis is 2, the absorbent composite is at least 32, 52 and 34 where coextensive, also see Figures 6 and 7 which show such composite having linear side edges, the side panels are at least portions 10 of element 20 which are attached and permanently bonded to the composite and extend transversely beyond the side edges thereof, the leg openings are 16, the waist opening is 12, targeted elastic material are the stretchable portions of 10 and the tension zones are disclosed at col. 7, lines 16-31. As best understood of the instant specification at page 2, last paragraph, page 3, lines 8-13 as amended, the definitions on page 7 and the manufacturing

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processes of Figures 9-12 and 16, at the very least the device is set forth at col. 7, lines 32-54, i.e. material or laminate made elastic by applying heat to inner layer 26 of laminate of 26 and 28 or by the thermal bonding process of 36, 48 which also makes 36, 48 elastic so is part of the single manufacturing process of making the zoned elastic material, i.e. the elastic or stretchable portions, e.g. 36, in the side panels 10 are the targeted elastic material and such panels are permanently bonded or attached to the composite and extend transversely beyond the linear side edges of the composite. It is noted that the claims also do not require the panels extend from side edges of the outermost layer of the garment which also forms the cover of the composite. The reference teaches a device which functions as set forth in claims 20-22 and 24. In claim 23, Applicant claims the device being swimwear which capability or function the reference does not explicitly teach. However, the Van Gompel patent teaches all the claimed structure. Therefore there is sufficient factual evidence for one to conclude that the properties and functions of such claimed structure would also be inherent in the same structure of the Van Gompel device. See MPEP 2112.01. With regard to claim 34 and 35, see cited portions supra, e.g., col. 7, lines 40-43, col. 6, lines 42-51, and col. 8, line 51-col. 9, line 23. See also response to Applicants' arguments *infra*.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321<sup>©</sup> may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 19-24 and 34-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19, 21, 50-59 of copending Application No. 09/855,188 in view of Van Gompel '052 and Bunnelle et al, '123. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the applications were filed on the same day the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. Note the definitions in the other application, i.e. "Disposable garment", "TEL" and "TEM", the definitions in the instant application, and claim language in both applications. The instant claims include 1) the TEM being in the side panel so as to have the one high tension zone aligned with either the leg or waist opening, a second high tension zone aligned with the other of the openings and the one low tension zone therebetween which specific gradient is in a side panel and a single manufacturing process which are not required by

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the claims of the other application, and the instant claims do not require 2) the specifics of claims 3-19, 51, 56 and 59 of the other application. With regard to 1), see cited portions of Van Gompel supra. To employ the claimed tension gradient in the laminate and the laminate in the side panel as taught by Van Gompel and as claimed in the instant application in the device as claimed in the other application claims would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide improved fit and the desirability of good fit in any garment to be worn and especially a absorbent garment, i.e. don't want it to leak. Also see Bunnelle et al, col. 11, lines 3- 61, i.e. an elastic can be directly contacted with a substrate or can be stored and attached to the substrate later, i.e. a single manufacturing process or a non single manufacturing process. Therefore to make the manufacturing process a single process, if not already, would be obvious to one of ordinary skill in the art in view of the recognition of the interchangeability as taught by Bunnelle et al. With regard to 2), the claims of the instant application are broader with regard to those claims of the other application, i.e. they claim more specific embodiments, and once the applicant receives a patent for a more specific embodiment he is not entitled to a patent for a broader or generic invention. This is because the specific anticipates the broader, see In re Goodman, supra.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 19-24 and 34-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 and 49-58 of copending Application No. 09/855, 189 in view of Van Gompel and Bunnelle et al, '123. Although the conflicting claims are not identical, they are not patentably distinct from each other



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because since the applications were filed on the same day the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. Note the definitions in the other application, i.e. "Disposable garment", "TEL" and "TEM", the definitions in the instant application and claim language in both applications. The instant claims include 1) the TEM being in the side panel so as to have the one high tension zone aligned with either the leg or waist opening, a second high tension zone aligned with the other of the openings and the one low tension zone therebetween which specific gradient is in a side panel, a single manufacturing process, and a first and second polymer compositions which are not required by the claims of the other application and the instant claims do not require 2) the specifics of claims 2-17, 19-23, 50, 55 and 58 of the other application. With regard to 1), see cited portions of Van Gompel supra. To employ the claimed tension gradient in the laminate and the laminate in the side panel as taught by Van Gompel and as claimed in the instant application in the device as claimed in the other application claims would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide improved fit and the desirability of good fit in any garment to be worn and especially a absorbent garment, i.e. don't want it to leak. Also see Bunnelle et al, col. 11, lines 3- 61, i.e. an elastic can be directly contacted with a substrate or can be stored and attached to the substrate later, i.e. a single manufacturing process or a non single manufacturing process. Therefore to make the manufacturing process a single process, if not already, would be obvious to one of ordinary skill in the art in view of the recognition of the interchangeability as taught by Bunnelle et al. With regard to the composition see discussion of claims 34-35, paragraph 7 supra, which rationale also applies here. With regard to 2), the claims of the instant application are broader

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with regard to those claims of the other application, i.e. those claims claim more specific embodiments, and once the applicant receives a patent for a more specific embodiment he is not entitled to a patent for a broader or generic invention. This is because the specific anticipates the broader, see *In re Goodman*, supra. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

11. Applicant's remarks with regard to matters of form have been considered but are deemed moot in that the issues discussed have not been reraised. Applicant's remarks with regard to Van Gompel have been considered but as previously set forth in Paper No. 17, such remarks are considered not persuasive because such remarks are narrower than the claim language which does not require the panels to extend transversely beyond the linear side edge of the outer cover of the garment, i.e. the claim language requires the side edge of the composite which is a absorbent, liner and outer cover where coextensive, and are also narrower than the claims and description, i.e. the claims only require a TEM in at least each of the front or back panels(the entire panel(s) or entire garment are not required to be TEM) and an "elastic" band is not separately manufactured and subsequently connected to the underlying material in Van Gompel but rather the laminate or material which is made of nonelastic materials is elasticized in the same process as making the elastic laminate or combination. It is noted that the methods as set forth in Figures 9-12 and 16 illustrate laminates in which the elastic material is formed and laminated in a single manufacturing line process but the elastic material is actually formed in the line prior to it being attached or connected to an underlying layer. Furthermore, these methods

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do not show that laminate or TEM being associated or combined with the remainder of the garment, e.g. the liner, the absorbent assembly, in the same manufacturing process, i.e. as best understood, the TEM is made in a single process, not necessarily the entire panel or garment. Applicants remarks with respect to the provisional double rejections have been noted but are deemed not persuasive since this is not the only rejection remaining nor has a terminal disclaimer been submitted.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. It is noted that even if panels were claimed that extend transversely outward beyond linear edges of an outermost layer of a composite of a garment Bridges '430 already made of record as well as Popp teach that elasticized side panels can be monolithically formed or integral. The Mishima et al patent shows panels with zones of elastic adhesive. The Hilston et al reference shows a film of elastic zones. Bunnelle et al '123 and Mleziva et al '102, already of record, also teach making elastic laminates in a single process.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 308-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
February 17, 2004